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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,496	11/28/2000	Zaid Joyyosi	02481.1691-00	6965
7590	01/29/2004		EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET NW WASHINGTON, DC 20005-3315			LIU, HONG	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,496

Applicant(s)

JOYYOSI ET AL.

Examiner

Hong Liu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7,11,14,15,21-23,27,31,34-37,49-82,89,91 and 93-97 is/are pending in the application.
- 4a) Of the above claim(s) 50-82 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,14,15,21-23,27,49 and 89 is/are rejected.
- 7) ☒ Claim(s) 11,31,34-37,91 and 93-97 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Claims 1-2, 7, 11, 14-15, 21-23, 27, 31, 34-37, 49-82, 89, 91 and 93-97 are pending in this application.

This action is in response to the applicants' amendment and reply filed on December 9, 2003.

Response to Arguments

Applicants' arguments and amendments filed on December 9, 2003 have been fully considered. Applicant's amendment, however, necessitated the new ground(s) of rejection presented below.

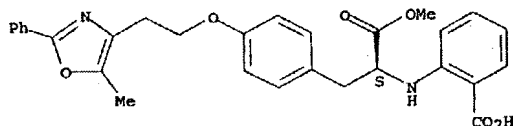
The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

Claims 1, 2, 7, 14, 15, 21-23, 27, 49, and 89 are rejected under 35 U.S.C. 102(b) as being anticipated by Willson et al. (WO 97/31907). Willson teaches the compounds and composition of the instant invention. See Examples on pages 12-20, in particular, compounds represented by the following structure where oxazolyl corresponds to Ar1, two phenyls correspond to ArII and ArIII, COO²H or C(O)-phenyl corresponds to Z, etc.

RN 196811-12-8 CAPLUS
CN L-Tyrosine, N-(2-carboxyphenyl)-O-[2-(5-methyl-2-phenyl-4-oxazolyl)ethyl]-
, .alpha.-methyl ester (9CI) (CA INDEX NAME)

Absolute stereochemistry.



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Rejections of claims under 35 U.S.C. 102(b) as being anticipated by Huang et al. and Jayyosi et al. are hereby withdrawn in view of applicants' amendments of ArI.

Claim Rejections - 35 USC § 103

Claims 1, 2, 7, 14, 15, 21-23, 27, 49, and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willson et al. (WO 97/31907). The reference teaches a generic group of compounds which embraces applicant's instantly claimed compounds. See formula I, Col. 3 wherein A is phenyl, B is a 5- or 6-membered heterocyclic group, Z can be NR₃R₄, etc. The compounds are taught to be useful as PPAR inhibitors. The claims differ from the reference by reciting a specific species and/or a more limited genus than the reference. However, it would have nevertheless been obvious to one skilled in the art at the time of the invention to be motivated to select any of the species of the genus taught by the reference including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the specie of the genus would have similar properties and, thus, the same use as taught for the genus as a whole, i.e., antithrombotic agents. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. It has been held that a prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. See *In re Susi*, 440 F.2d 442, 169 USPQ 423, 425 (CCPA 1971), followed by the Federal Circuit in *Merck & Co. V. Biocraft Laboratories*, 847 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

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Rejection of claims under 35 U.S.C. 103(a) as being obvious over Jayyosi et al. is hereby withdrawn in view of applicants' amendments of ArI.

Claim Rejections - 35 USC § 112

Rejection of claims under 35 U.S.C., 112, first paragraph, is hereby withdrawn in view of applicant's amendments.

Rejection of claims under 35 U.S.C., 112, second paragraph, is hereby withdrawn in view of applicant's arguments.

Claim Objections

Claims 11, 31, 34-37, 91, and 93-97 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the prior art of record nor a search in the pertinent art area teaches the exact species.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 358-1235.


Richard L. Raymond
Primary Examiner
Mukund Shah
Art Unit 1624
Supervisory Patent Examiner
Art Unit 1624

hl
January 15, 2004